35 U.S.C. § 103(a) if the application qualifies as prior art under 35 U.S.C. § 102(f) or (g) and the allegedly conflicting inventions were not commonly owned at the time the invention in this application was made.

In paragraph 14 of the Office Action, the Examiner alleged that claims 37-38, 40-42, 45-47, 49-51, 54, 73-76, 79-81, 84-86, 89, 100-101, 104-108, 110-113, 115-116, 118-120, 123-125, 127-129, 132-136, 139-141, 144-146, 149-151, 154-158, 160-163, 165-166, 168-170, 173-175, 177-179, 182-186, 189-191, 194-196, 199-201, 204-208, and 210-213 are directed to an invention not patentably distinct from claims 1-100 of commonly assigned application serial no. 09/859,053. In addition, the Examiner stated that application serial no. 09/859,053 would form the basis of a rejection under 35 U.S.C. § 103(a) if the application qualifies as prior art under 35 U.S.C. § 102(f) or (g) and the allegedly conflicting inventions were not commonly owned at the time the invention in this application was made.

As detailed in the enclosed statement under 37 C.F.R. § 1.78(c), the present application, application serial no. 09/830,548, and application serial no. 09/859,053, were each owned by or subject to an obligation of assignment to Japan Tobacco, Inc. at the time the inventions disclosed and claimed in the respective applications were made. The enclosed statement precludes a rejection under 35 U.S.C. § 103(a) based upon the use of either of commonly assigned application serial no. 09/830,548 or 09/859,053 as a reference under 35 U.S.C. § 102(f) or (g). In addition, neither of the commonly assigned applications qualifies as prior art against the present application under 35 U.S.C. § 102(e).

Obviousness-Type Double Patenting

In paragraph 10 of the Office Action, the Examiner provisionally rejected claims 37-54, 73-89, and 100-214 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-7, 10-15, 18-22, and 25-50 of copending and commonly assigned application serial no. 09/830,548.

In paragraph 13 of the Office Action, the Examiner rejected claims 37-38, 40-42, 45-47, 49-51, 54, 73-76, 79-81, 84-86, 89, 100-101, 104-108, 110-113, 115-116, 118-120, 123-125, 127-129, 132-136, 139-141, 144-146, 149-151, 154-158, 160-163, 165-166, 168-170, 173-175, 177-179, 182-186, 189-191, 194-196, 199-201, 204-208, and 210-213 under the judicially

created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-100 of copending and commonly assigned application serial no. 09/859,053.

The above rejections are provisional obviousness-type double patenting rejections because the allegedly conflicting claims of application serial nos. 09/830,548 and 09/859,053 have not been patented.

As detailed in MPEP § 804, a provisional obviousness-type double patenting rejection can be appropriate when "the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent." However, MPEP § 804.I.B. instructs that

> [t]he "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. (emphasis added)

Because the provisional obviousness-type double patenting rejections are the only rejections remaining in the present application, the Examiner should withdraw the rejections and permit the present application to issue as a patent. In addition, because neither application serial no. 09/830,548 nor application serial no. 09/859,053 has issued as a patent, no terminal disclaimer is required for the present application. Accordingly, applicants respectfully request that the Examiner withdraw the rejections.

CONCLUSION

Applicants submit that all grounds for rejection have been overcome, and that all claims are now in condition for allowance, which action is requested.

Enclosed is a Petition for One Month Extension of Time and check for the extension of time fee. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 14539-004001.

Respectfully submitted,

Date: February 13, 2003

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